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SCHIFF HARDIN LLP  
Patent Department  
6600 Sears Tower  
233 South Wacker Drive  
Chicago, IL 60606

EXAMINER
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CHAO, ELMER M

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

1 RECORD OF ORAL HEARING  
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3 UNITED STATES PATENT AND TRADEMARK OFFICE  
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6 BEFORE THE BOARD OF PATENT APPEALS  
7 AND INTERFERENCES  
8  
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10 *Ex parte* MICHAEL MASCHKE  
11  
12

13 Appeal 2009-007413  
14 Application 10/804,707  
15 Technology Center 3700  
16  
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18 Oral Hearing Held: June 17, 2010  
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21 Before WILLIAM F. PATE, III, STEFAN STAICOVICI,  
22 FRED A. SILVERBERG, *Administrative Patent Judges*.  
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24 APPEARANCES:  
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27 ON BEHALF OF THE APPELLANT:  
28  
29

30 STEVEN H. NOLL, ESQUIRE  
31 Schiff, Hardin, LLP  
32 6600 Sears Tower  
33 Chicago, Illinois 60606  
34 (312) 258-5790  
35  
36  
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1           The above-entitled matter came on for hearing on Thursday, June 17,  
2   2010, commencing at 9:32 a.m., at the U.S. Patent and Trademark Office,  
3   600 Dulany Street, Alexandria, Virginia, before Paula Lowery, Notary  
4   Public.

5   CLERK: Good morning, Calendar Number 46, Appeal No. 2009-007413,  
6   Mr. Noll.

7   JUDGE PATE: Good morning, Mr. Noll.

8   MR. NOLL: Good morning.

9   JUDGE PATE: We've taken an opportunity to look at this case beforehand,  
10  so we're up to speed on the technology. We'd like to hear your arguments  
11  about patentability.

12  MR. NOLL: My pleasure. As you know, our basic reference is the  
13  Lenelson reference. We have a rejection under 103 based on Lenelson and  
14  Koch.

15  I won't say too much about the Koch reference. The Examiner relied on it  
16  because it has a magnet at the tip. We agree it provides such a teaching, but  
17  that's not really our basis for patentability, or our basis for distinguishing  
18  over the art.

19  So I'll devote most of my time to discussing the Lenelson reference. As you  
20  know from reading the Briefs, our claimed invention is a catheter that is  
21  magnetically guided in the body of a patient by means of a static magnetic  
22  field in which the catheter and the patient are placed.

23  The catheter itself contains a number of individually controllable  
24  electromagnets that are each controlled so as to give the respective  
25  electromagnets different magnetic moments. That allows a very robust

1 guidance of the catheter through the body in this magnetic field by  
2 interaction of the electromagnets with the static, external magnetic field.  
3 The Lenelson reference, as a fundamental difference, is a catheter that has  
4 either permanent magnets or electromagnets in it that is placed in an external  
5 field where the external field is the controlled field. By controlling the  
6 external field and by interaction of that controlled external field with the  
7 magnets, the Lenelson guidance of the catheter is achieved in that manner.  
8 The key point, as you can see from our Briefs, is whether the Lenelson  
9 reference discloses that any of these magnets in the catheter have different  
10 magnetic moments when the current is supplied to them.  
11 As we've noted, the primary disclosure of the Lenelson reference is, we  
12 think, to use permanent magnets; but it does make mention of an alternative  
13 use of electromagnets. For the reasons which we cited in our Brief, which I  
14 won't detail again, the electromagnets are described in Lenelson, we believe,  
15 only as alternatives, or something that will be operated or used to resemble  
16 the permanent magnet.  
17 That by itself to us says they are not, should not, and cannot be individually  
18 controllable electromagnets. Otherwise, they wouldn't resemble the use of  
19 the permanent magnets.  
20 Even more importantly, this reference, of course, was heavily discussed  
21 during the prosecution before the Examiner; and we specifically amended  
22 our claim language to preclude the interpretation of this reference that the  
23 Examiner is now giving. That is, to include specific language in our claim  
24 that states that the electromagnets that have different magnetic moments are  
25 magnets that have current supplied to them.

1 The Examiner is only able to interpret the Lenelson reference as having  
2 electromagnets with different magnetic moments by virtue of saying that  
3 some of these electromagnets at any given time might be activated. Some  
4 might be not activated, and the Examiner contends that the nonactivated  
5 magnets thus have a magnetic moment of zero.

6 Our position is a nonactivated electromagnet is no different than the example  
7 we gave in our Brief of a pencil, or any other inanimate object, without any  
8 current supplied to it for which the concept of a magnetic moment is  
9 meaningless.

10 It's only useful and meaningful to use the concept of a magnetic moment to  
11 something that is actually generating or exhibiting a magnetic field. A  
12 nonactivated electromagnet just doesn't do that.

13 You can take that concept of the Examiner to the extreme and say something  
14 that is red could also be called green because at any given moment it has a  
15 green value of zero. So this is a very slippery slope, we believe, to just call  
16 something that has no magnetic attributes at all as having a magnetic  
17 moment of zero.

18 That's the one factor just in terms of whether any of these magnets have  
19 different magnetic moments; but it's also a distinguishing feature, we  
20 believe, with regard to the Lenelson catheter that even the activated magnets  
21 in that catheter when activated are all activated the same. They're all  
22 supplied with the same current.

23 As I said, they're intended to resemble permanent magnets, which means  
24 they must all be virtually identical. So even for the activated magnets in the  
25 Lenelson catheter, none of them have different or varying magnetic  
26 elements. They all have the same identical magnetic moment.

1 That's basically our argument. The fundamental difference between the type  
2 of control that's used in the catheter -- this catheter of the invention is used  
3 in an external static field. The Lenelson reference is used in an external  
4 controllable field. There's no magnets with varying magnetic moments  
5 disclosed in the Lenelson, et al. reference; and there's no electromagnets that  
6 are individually controllable disclosed in the Lenelson reference.

7 All of those factors, we believe, actually teach a person of ordinary skill  
8 away from making any modifications of the Lenelson reference in a  
9 direction toward the claimed subject matter. Even if those sorts of changes  
10 proposed by the Examiner were made for reasons that we're not able to  
11 discern, that would involve such a substantial redesign of the Lenelson  
12 system to change it from the basic fundamental operating concept that's  
13 disclosed in that reference that we believe those changes would themselves  
14 be evidence of nonobviousness and be sufficient to reverse the rejection.  
15 I'd be glad to take any questions or hear any comments you have.

16 JUDGE PATE: Any questions?

17 JUDGE STAICOVICI: I have one question. Lenelson specifically states  
18 using strong magnets, or more preferably, electromagnets in it. So I get the  
19 feeling that they prefer electromagnets to permanent magnets.

20 MR. NOLL: That might be the case, I wouldn't dispute that; but even if  
21 that's the case, as I said, the use of electromagnets is intended to cause them  
22 to behave as closely as possible to permanent magnets. Even when they use  
23 permanent magnets in order to achieve the feature that I mentioned of  
24 having some magnets activated and some magnets deactivated, they talk  
25 about putting the permanent magnets at different locations along the length  
26 of the catheter.

1 So whatever they're doing, whether they're using permanent magnets or  
2 electromagnets, I believe they're trying to accomplish the same thing and  
3 make them resemble each other as closely as possible.

4 JUDGE PATE: I think we understand your arguments, and we're going to  
5 take this case under advisement.

6 MR. NOLL: Thank you very much.

7 JUDGE PATE: Thank you.

8 Whereupon, the proceedings at 9:41 a.m. were concluded.

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